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09/292,096	04/14/1999	JEFFREY M. GARIBALDI	3176-4866	3084

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BRYAN K. WHELOCK  
HARNES, DICKEY & PIERCE, P.L.C.  
7700 BONHOMME AVENUE  
SUITE 400  
ST. LOUIS, MO 63105

EXAMINER

LEUBECKER, JOHN P

ART UNIT

PAPER NUMBER

3739

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19

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Reply  
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APPLICATION NO/ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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Commissioner of Patents and Trademarks

John P. Leubecker  
Primary Examiner  
Art Unit: 3739

**RESPONSE TO REPLY BRIEF**

In reply to Appellants' Reply Brief filed November 12, 2002.

**The Rejection Under 35 U.S.C. 112**

It is impossible for the Examiner to determine whether or not every person of ordinary skill in the art would understand that reference to "the display" would be referring to the previously recited "the display component". However, since Appellant can not even maintain a consistent correspondence between these terms<sup>1</sup>, the Examiner feels justified to maintain the position that there is a good chance that there may be a discrepancy between people of ordinary skill in the art when interpreting the claims. It is the Examiner's job to ensure, as best as he can, that the claims are as clear and concise as possible for interpretation. Why can't "the display" be changed to "the display component" if that is what it is referring to? The addition of the word "component" surely does not make the claim "lengthy" or "incomprehensible". The mere fact that Appellant is vehemently arguing to keep these terms separate and inconsistent with each other seems a little odd and suspicious to the Examiner.

Furthermore, Appellant believes that shorted references to lengthy claim elements enhances the comprehendability of a claim. The Examiner agrees. However, the Examiner does not consider "the display component" as a lengthy claim term, and takes the position that its *consistent* use only would enhance comprehendability of the claim. And for the record, a

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<sup>1</sup> Note that in Appellant's Appeal Brief filed August 5, 2002, Appellant states that "the display" is a "clear and unmistakable reference to the *display on the display component*" (emphasis added) (note bottom of page 6). In contrast, in Appellant's Reply Brief filed November 12, 2002, Appellant states that the display "would be understood by a person of ordinary skill in the art *as referring to the display component*" (emphasis added)(note top of page 2).

shortened reference to that particular claim term would more properly be "the component". Normally, the element is referenced as what it is, and not by its descriptive part.

### **The Rejection Under 35 U.S.C. 102**

Appellant from the beginning has repeatedly stressed the fact that the magnetic field and the magnetic gradient are different. The Examiner agrees. However, this is not the issue. The Examiner's position is based on the fact that, even if the Ueda reference did not disclose generation of a magnetic field (and it does), a magnetic field and magnetic gradient are coexistent. Every instance where Ueda mentions a magnetic gradient, there is a magnetic field inherently present. When a magnetic gradient is applied, so is a magnetic field. When the magnetic gradient is changed or moved, the magnetic field is changed or moved. Thus, the Examiner takes the position that use of Ueda's magnetic field/gradient meets the limitations as broadly as claimed.

Furthermore, the Examiner also agrees that the magnetic field and magnetic gradient are typically in different directions. However, when a magnetic gradient is applied to change the orientation of the magnetic body, so is a magnetic field, whether in the same direction or not. Thus, a magnetic field of a specific direction is applied to change the orientation of the magnetic body.

Appellant again mentions that the alleged invention controls "the direction of the magnetic field (and **not** its gradient or pulling force) to align a magnetically responsive element in the direction of the applied field". The Examiner respectfully warns Appellant not to get what might be disclosed confused with what is encompassed by the broad language in the claims. All

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this does is confuse the issues between the claim language and the prior art. As previously pointed out, the claims do not recite the control of the *direction* of the magnetic field or the action of *aligning* the magnetic body *in the direction* of the applied field.

In addition, Appellant has not addressed the Examiner's citation of certain portions of the Ueda reference that explicitly mention application of a magnetic field. See col.16, lines 30-43 and col.26, lines 14-36. These citations explicitly explain that a magnetic **field** is generated and through a magnetic force (perhaps a gradient), the magnetic body at the tip of the endoscope is moved/oriented. Thus, to recap, a **magnetic field** is applied and the position of distal end of the endoscope is **changed**. Isn't that what Appellant is claiming?

Appellant also states that "No where does Ueda et al. teach or suggest applying particular magnetic field direction to control a device". The Examiner respectfully disagrees. As previously pointed out with respect to Figures 3A, 3B, 7, 8A and 8B of Ueda, a selectively oriented magnetic field is applied to change the orientation of the magnetic body. Whether a gradient force is use to move the magnetic body is irrelevant--by selectively orienting the direction of the magnetic field, the force generated by this changing magnetic field changes the orientation of the magnetic body. That essentially is what is being claimed.

## Conclusion

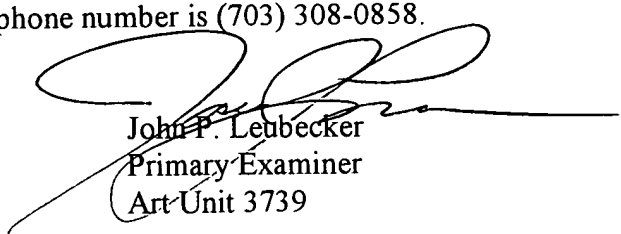
For the reasons set forth in the Examiner's Answer and supplemented by the remarks made above, the Examiner believes that the rejections should be sustained.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl  
January 3, 2003